

C1
the upper arm part and the forearm part being connected to one another by a connecting strap in an adjustable and substantially flexible manner, and a support strap being arranged on the upper arm part and a holding strap being arranged on the forearm part said holding strap being adapted to pass behind the back of a patient to the upper arm part and form a loop around the upper arm part, thereby holding the forearm part against the body of said patient.

Claim 9, please cancel.

Please add the following new claim:

C2
--Claim 21. Bandage according to Claim 1, wherein said support strap begins at an end which is attached to the forearm part, runs thence along the upper arm part and continues from the upper arm part to a point at which it is divided into two parts, the first of said two parts being adapted to fit dorsally around the thorax of a patient and then to continue ventrally over the thorax of said patient to the forearm part, and loop around the forearm part and back upon itself; the second of said two parts being adapted to run from said point ventrally over the thorax of said patient to intersect and rejoin said first part. --) new matter

REMARKS

This application pertains to a novel bandage for the shoulder and upper arm area

of a patient.

Claims 1-8 and 10-21 are pending. Claim 9 has been rewritten as new claim 21.

Applicants have previously submitted *three* proposed corrected drawings; Figs. 3, 4 and 5. The Examiner has objected to the drawings because she finds features of *Figure 5* to be unsupported in the Specification. This, however, has nothing to do with the proposed corrections to Figures 3 and 4, which concern the addition of a designating number only.

Reconsideration and approval of the proposed corrections to Figures 3 and 4, as shown in the corrected drawings annexed to the response filed 28 June, 2002, is respectfully requested.

As to Figure 5, Applicants have carefully considered the Examiner's comments, but believe that Figure 5 accurately illustrates the invention as described in the specification.

To this end, Applicants enclose a copy of Figure 5, to which they have added explanatory text to indicate the consistency between the drawing and the specification. The Examiner is respectfully requested to consider the explanatory text and, in view of said text, approve the entry of Figure 5, as submitted with the amendment of 28 June 2002.

The amendment filed 06/28/02 stands objected to and Claim 9 rejected under 35 U.S.C. 112, first paragraph, because the Examiner finds the amendment of Claim 9 to recite that the first end is split into two **forks** as unsupported. The Examiner points out that page 3, lines 38-39, refer to the strap as partially divided into two **parts**.

Claim 9 has now been cancelled and replaced by new claim 21. New claim 21 is a rewritten version of Claim 9, which more completely describes the configuration of the support strap. Support for Claim 21 can be found in the text at page 3, line 38 - page 4, line 2; page 7, line 38 - page 8, line 21; Fig. 3 and Fig. 4).

not as ~~at~~ mentioned 2 parts

OR 2 parts

but not to 08

In view of the cancellation of Claim 9 and its replacement by Claim 21, the objection to the amendment of 6/28/02, as well as the 35 U.S.C. 112, first paragraph rejection of claim 9, should now be withdrawn.

The rejection of Claim 9 under 35 U.S.C. 112, second paragraph, is also believed to be obviated by cancellation of said claim and its replacement by new claim 21. This rejection should accordingly now be withdrawn.

Claims 1, 3-6 and 10 stand rejected under 35 U.S.C. 102(b) as anticipated by Abolina (SU 321252).

In Abolina, the shoulder piece crosses behind the neck and covers both

shoulders, not just one shoulder as Applicants' upper arm part does. More importantly, Abolina has only one support strap, which runs straight down in front of the left shoulder to the forearm piece, and then around the back to the upper arm support.

In Applicants' device, by contrast, the strap starts out at the end of the forearm part (2), where it is attached by stud (52), then runs up the upper arm part, around the neck and down to the forearm part.

In addition, Applicants' device has a holding strap (5) which starts from the forearm part (by the hand in Figs. 4 & 5), runs behind the back and is guided around the upper arm part in a loop and is then fixed to itself (to close the loop). In Figure 4 and 5, one can see the end of support strap (5), guided around the upper arm in a loop (shown transparently just above the number "2" in Figure 4). Abolina, by contrast, discloses only one strap (3), which does not run behind the back and go around the upper arm part. Abolina's strap 3 is only a loop strap for the left shoulder and the left shoulder piece. Abolina's straps 5 go only around the arm to fix the bandage.

Thus, Applicants' holding strap (5) holds the forearm part against the body, whereas Abolina's support allows the forearm to move away from the body, because there is no strap running from it behind the back to an upper arm part.

Accordingly, Applicants' bandage is different than Abolina's broken arm support in several different ways. Abolina cannot therefore possibly anticipate Applicants'

bandage or render Applicants' bandage obvious, and the rejection of Claims 1, 3-6 and 10 under 35 USC 102(b) as anticipated by Abolina should now be withdrawn.

Claims 1-2 and 7-8 stand rejected as obvious over Munoz in view of Abolina.

Applicants have previously pointed out that Munoz requires a rigid brace bar (not a connecting strap), and does not have any holding strap for fixing the forearm in position, such as Applicants holding strap 5.

To this, the Examiner seems to argue that Munoz's element 44 in Figure 4 is a holding strap. The Examiner does not address the absence of a connecting strap in Munoz.

Nevertheless, Applicants have now amended Claim 1, to more specifically recite that their connecting strap is flexible (page 8, line 1) and adjustable, and that the holding strap passes from the forearm part, around the back of a patient and loops around the upper arm part (page 8, lines 16-21).

Munoz's forearm part and upper shoulder part are attached to each other by a rigid bar (26), not a flexible strap; and Munoz's strap (44) does not in any way hold the forearm part to the body, but merely holds the forearm in the forearm part, just like Abolina's straps (5).

The Examiner contends that she has added Abolina to Munoz only to show the inclusion of half shells. The addition of half shells to Munoz will not overcome any of the differences discussed above, however.

The rejection of Claims 1-2 and 7-8 under 35 U.S.C. 103 (a) as obvious over Munoz in view of Abolina should accordingly now be withdrawn.

Claims 11-12 and 20 stand rejected under 35 U.S.C. 103 (a) as obvious over Munoz in view of Abolina, as applied to Claim 1 above, and further in view of Johnson.

The Examiner cites Johnson as suggesting straps made from laminated foam. Laminated foam will not, however, overcome the deficiencies of the Munoz/Abolina combination of references discussed above. No combination of Munoz, Abolina and Johnson will ever lead to Applicants' novel bandage, and the rejection of claims 11-12 and 20 under 35 U.S.C. 103(a) as obvious over Munoz in view of Abolina as applied to Claim 1 above, and further in view of Johnson (4,550,869) should be withdrawn.

Claim 9 stands rejected under 35 U.S.C. 103(a) as obvious over Abolina in view of Verter (US 4,446,858). The Examiner acknowledges that Abolina does not disclose the first end splits or forks immediately after the point at which it is attached to the upper part. The Examiner would overcome this deficiency with Verter's teaching of Verter's front and rear straps 18 and 19.

This rejection is obviated by the cancellation of Claim 9. Nevertheless, Applicants comment on said rejection, as it might be applied to new claim 21.

The Examiner overlooks that in Applicants' bandage (of former claim 9 or new claim 21), the first of the two divided parts of the support strap is adapted to fit dorsally around the thorax of a patient and then to continue ventrally over the thorax of the patient to the forearm part, then loop around the forearm part and back upon itself; while the second of said two parts is adapted to run ventrally over the thorax of the patient to intersect and rejoin the first part. All Verter's two straps do is run around the thorax of the patient, for support. In addition, Verter's straps 18 and 19 are two separate straps, they are no split parts of a single strap.

In addition, nothing in Verter would overcome the further differences between Applicants' bandage and Abolina's broken arm support, discussed above.

Accordingly, no combination of Abolina and Verter could possibly lead those skilled in the art to arrive at the bandage of Applicants former claim 9 or new claim 21, and neither of said claims can reasonably be seen as obvious over Abolina in view of Verter.

Claims 13-15 and 19 stand rejected under 35 U.S.C. 103(a) as obvious over Abolina in view of Ford (4,214,579). Here, the Examiner cites a secondary reference for a teaching of specific materials of construction. Applicant's bandage

differs from Abolina's support both structurally and functionally, as discussed above. The substitution of one material of construction for another cannot possibly overcome these structural and functional differences. The Ford reference, when added to Abolina, will never lead to the structural changes that would be required to arrive at Applicants' bandage. Applicants claims cannot therefore be seen as obvious over Abolina in view of Ford, and the rejection of claims 13-15 and 19 under 35 U.S.C. 103(a) as obvious over Abolina in view of Ford (4,214,579) should be withdrawn.

Finally, claims 16-18 stand rejected under 35 U.S.C. 103(a) as obvious over Abolina in view of Ford, as applied above and further in view of Cherubini. The Examiner cites Cherubini for a suggestion of heating the support between a positive and negative mold. This, however, will not overcome the structural and functional differences between Applicants' bandage and the subject matter taught by the Abolina/Ford references, discussed above. The rejection of claims 16-18 under 35 U.S.C. 103(a) as obvious over Abolina in view of Ford, and further in view of Cherubini should therefore be withdrawn.

In view of the present amendments and remarks, it is believed that claims 1-8 and 10-21 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested, and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution

record in better condition for appeal.

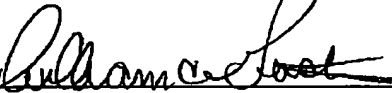
CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this amendment is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to deposit Account No. 14-1263

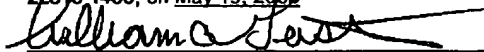
Respectfully submitted
NORRIS, McLAUGHLIN & MARCUS

By 
William C. Gerstenzang
Reg. No. 27,552

WCG:tmh

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

I hereby certify that this correspondence is being transmitted via facsimile addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450, on May 19, 2003



Date May 19, 2003

**MARKED-UP COPY OF AMENDED CLAIM, SHOWING CHANGES RELATIVE
TO PREVIOUS VERSION**

Claim 1 (twice amended). Bandage for the shoulder and upper arm area, comprising an anatomically shaped upper arm part which is adapted to receive the upper arm of a patient, and an anatomically shaped forearm part which is adapted to receive the forearm of said patient,

the upper arm part being designed in the shape of a half shell and having a recess adapted to fit over and enclose the shoulder joint of said patient in said half shell, and

the forearm part being designed in the shape of a half shell and having an enclosure for the elbow joint, and

the upper arm part and the forearm part being connected to one another by a connecting strap in an adjustable and substantially flexible manner, and a support strap being arranged on the upper arm part and a holding strap being arranged on the forearm part said holding strap being adapted to pass behind the back of a patient to the upper arm part and form a loop around the upper arm part, thereby holding the forearm part against the body of said patient.